

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has added claim 72-74. Claim 41 has been amended. Applicant respectfully submits no new matter has been added. Accordingly, claims 27-74 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 112

Claim 41 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter as the invention. Claim 41 has been amended to correct the antecedent basis problem. Withdrawal of the rejection is respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 102(e)

Claims 27-71 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Van Den Heuvel, *et al.* (US 6,223,030). The Applicant respectfully traverses the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicant and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Van Den Heuvel the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within the reference being relied upon in the rejection, the Examiner has essentially forced Applicants to engage in mind reading and/or guessing to determine how the Examiner is

interpreting the elements of the claims and what specific features within the reference the Examiner believes identically disclose the claimed invention.

In effect, the Examiner is placing the burden on Applicant to establish that the reference does not disclose the claimed elements based upon Applicant's interpretation of the claims and Applicant's comparison of the claims with the applied prior art. However, this shifting of burden, from the Examiner to Applicant, is premature since the Examiner has not discharged the initial burden of providing a prima facie case of anticipation. Applicant also notes that any continuing disagreement between Applicant and the Examiner as to whether or not a particular claimed feature is disclosed by the reference is a direct result of a lack of specificity by the Examiner in the statement of the rejection.

In the present matter, corresponding elements of the Van Den Heuvel reference have not been shown with specificity to teach each and every element of the present claims. Specifically, for example, the Examiner argues that "a data mechanism for exchanging handover information through said network node structure with said multi-mode radio as said multi-mode radio is to be handed-over to at least one of said foreign cells, said data mechanism comprising a container structure comprising content expressed in the foreign communications protocol so that the node structure can serve as a conduit for the container and need not understand the content of the container structure", as recited in claim 27 is taught by Van Den Heuvel at figs. 2-3, step 31-42, col. 2, line 66 – col. 4, line 16. The Examiner has clearly not shown where each element and the interaction of elements is taught or disclosed in the reference. It is impossible for the Applicant to know how specific elements of Van Den Heuvel are being applied to the elements of Applicant's claims. In the interest of facilitating a more focused and compact prosecution, Applicant respectfully requests either a telephonic Examiner interview or a new non-final Office Action.

4.) New Claims

New claims 72-74 have been added. Support for these new claims can be found at page 6, lines 4-7 of the originally filed Application.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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